

## REMARKS/ARGUMENTS

Claims 1-6, 8, 10-14, 16-22, and 25-39 are pending in the present application and remain in this application for prosecution. None of the claims has been amended. The Listing of Claims has been included for the convenience of the Examiner.

### **Finality of Office Action**

The first Office Action, dated May 8, 2006, had rejected dependent claims 7, 15, and 24 as being unpatentable over U.S. Patent Application Publication No. 2004/0248651 to Gagner (“Gagner”) in view of U.S. Patent No. 6,210,275 to Olsen (“Olsen”), and dependent claim 9 over Gagner in view of U.S. Patent No. 6,089,976 to Schneider (“Schneider”). The first Office Action had also rejected dependent claim 23 as being anticipated by Gagner. Thus, dependent claims 7, 9, 15, 23, and 24 were all rejected primarily based on Gagner

In response to the first Office Action, the Applicants incorporated the subject matter of claims 7, 9, 15, 23, and 24 into the respective independent claims and successfully argued that Gagner is not a proper reference. The Applicants did not make any other amendments.

The current Final Office Action acquiesces that Gagner is not a proper reference for rejecting the claims and has replaced the original 35 U.S.C. § 102 rejection with a 35 U.S.C. § 103 rejection. The Final Office Action relies now on Olsen as a primary reference in the rejection of the claims and a new reference, U.S. Patent No. 6,517,073 to Vancura (“Vancura”), as a secondary reference. Further, the Final Office Action notes that the action was made final because “Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action.”

The Applicant’s sole amendments were made only to include the claimed subject matter from a number of dependent claims into their respective independent claims. Thus, the Applicants did not switch from one subject matter to another in the claims. To reach a clearly defined issue, the Manual of Patent Examining Procedure (“MPEP”) admonishes to refrain from “[s]witching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter” because this

will “tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.” MPEP, Eighth Ed., Rev. 5, Aug. 2006, § 706.07, p. 700-81 (emphasis added).

The Applicants understand that the rules “no longer give to an applicant the right to ‘amend as often as the examiner presents new references or reasons for rejection.’” *Id.* Nevertheless, in this case it appears that prosecution was prematurely cut off by switching to a new set of references even though the claims claimed substantially the same subject matter. In accordance with the MPEP, the “applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application.” *Id.* Because the Examiner is relying on a new set of references to reject substantially the same claimed subject matter, the Applicants respectfully request that the finality of the office action be removed if the claims are not deemed allowable in accordance to the arguments provided below.

### **§ 103 Rejections**

Claims 1, 2, 4-6, 14, 16-22, 25, 27-33, and 36-69 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Olsen in view of Vancura. Claim 3 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Olsen in view of Vancura and further in view of U.S. Patent No. 6,203,429 to Demar *et al.* Claims 8-14, 34, and 35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Olsen in view of Vancura and further in view of U.S. Patent No. 6,155,925 to Giobbi *et al.* Claims 1, 8, 14, 19, 27, and 32 are the only independent claims.

*Regarding claims 1, 2, 4-6, 14, 16-22, 25, and 27-31, they are each directed to a “side wager.”* For example, claim 1 is directed to “a method for allowing players at a plurality of gaming terminals to place side wagers” that includes “sending a side wager inquiry signal to a second one of the plurality of gaming terminals” and, in response to receiving the side wager inquiry signal, displaying a communication . . . inquiring whether the player desires to make a side wager on an event that may occur in the progressive game.”

To better understand the invention, a brief explanation of an exemplary embodiment appears necessary. Player A begins conducting a basic wagering game on Machine A. While playing the basic game, a progressive game is randomly triggered. When the progressive game is triggered, player A has the opportunity to play the progressive game. In addition, when the progressive game is triggered non-participant players (*e.g.*, players B, C, D, etc.) receive an opportunity to make side wagers by predicting a progressive game outcome for player A. In other words, players B, C, and D do not participate in the progressive game, but are instead participating in their own wagering games at their own terminals. Thus, it is irrelevant to them whether a winning outcome is achieved in the progressive game. The non-participant players' interest is only whether their predictions were correct regarding player A's outcome. For example, player B may predict that player A will lose the progressive game. If player A loses the progressive game, player B will receive an award based on his or her side wager.

In contrast, the alleged "side wagers" disclosed by Olsen are merely additional wagers made by a (same) participant player to be able to play a bonus game at his or her respective terminal. Specifically, Olsen describes that "players wager a separate coin for the purpose of the bonus mode only. In other words, a separate "side" wager is required for eligibility into the bonus game, and the side wager can fully fund the jackpot pools 100%." Olsen, col. 14, ll. 18-23. The "separate coin," or "separate side wager," has nothing to do with being a side wager as claimed in the current invention. The "separate coin" is an additional wager that the same player, who is a participant in the wagering game, must provide to be eligible for playing a bonus game. The same player at the same terminal provides this additional (alleged "side") wager.

Thus, Olsen fails to teach a "side wager" as claimed by the claimed invention. Simply because Olsen uses the term "side wager" does not mean that Olsen discloses the claimed invention. If the Examiner believes that a different term may be more appropriate than the term "side wager," the Applicants would gladly take under consideration any suggested claim amendments.

Nevertheless, the Applicants respectfully submit that regarding claim 1, Olsen fails to teach at least "sending a side wager inquiry signal to a second one of the plurality of gaming

terminals” or “in response to receiving the side wager inquiry signal, displaying a communication to a player of the second one of the plurality of gaming terminals inquiring whether the player desires to make a side wager on an event that may occur in the progressive game.” Regarding claim 8, Olsen fails to teach at least “transmitting a side wager inquiry to a second one of the plurality of gaming terminals” or “in response to the transmitting, transmitting a side wager response signal from the second one of the plurality of gaming terminals.” Regarding claim 14, Olsen fails to teach at least “a second one of the plurality of interconnected gaming terminals placing a side wager on an event that may occur in the progressive game.” Regarding claim 19, Olsen fails to teach at least “a first one of the plurality of interconnected gaming terminals receiving a side wager inquiry signal in response to a second one of the plurality of interconnected gaming terminals achieving a progressive game” or “the side wager inquiry signal causing a side wager inquiry to be displayed to a player of the first one of the plurality of interconnected gaming terminals.” Regarding claim 27, Olsen fails to teach at least “a first one of the plurality of gaming terminals capable of making a side wager on an event that may occur in a progressive game to be played on a second one of the plurality of gaming terminals” or “signage displaying the progressive game that is played from the second one of the plurality of gaming terminals and the event on which the side wager is made at the first one of the plurality of gaming terminals.”

*Regarding claim 32, along with dependent claims 33-39, Olsen fails to teach at least a “signage including a local controller for randomly selecting a progressive game outcome of the progressive wagering game.” At most, Olsen teaches a separate large screen display 60 and a controller 120, which is separate (*i.e.*, not local) from the large screen display 60.*

Thus, the Applicants respectfully submit that all the rejected claims are patentable over any combination of references including Olsen at least for the above-stated applicable reasons.

## **Conclusion**

It is the Applicants’ belief that all the pending claims are now in condition for allowance, and thus reconsideration of this application is respectfully requested. If there are

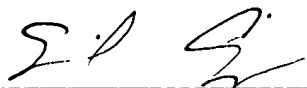
Application No. 10/612,478  
Amendment Dated February 16, 2007  
Reply to Final Office Action Dated January 17, 2007

any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

It is believed that no fees are due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkens & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47079-00207USPT.

Respectfully submitted,

Date: February 16, 2007

By  \_\_\_\_\_

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